

REMARKS

The Office Action of October 20, 2005, was received and its contents carefully reviewed. Claims 1-45 were originally presented for examination. Claims 1-13, 19-22, 32-35, and 40-48 were previously withdrawn in response to a Restriction Requirement. New claims 49-55 were added in the above Amendment. Claims 14-18; 23-31; 36-39; and 49-55 are currently pending.

Applicants thank the Examiner for her consideration and assistance during the personal interview conducted on March 29, 2006, at the United States Patent and Trademark Office. During the interview, Applicants presented information related to pharmacy benefits systems and the additional needs in the state of the art. Applicants further discussed features and benefits of the present invention and the previous claims that solve these needs in the art.

Applicants amended independent claims 14 and 27 above to provide additional details of the present invention and to recite the pending method claims using active steps. The features incorporated in the above amendments are disclosed at least in paragraphs [0016, 0045-0054] and throughout the specification. Likewise, new claims 49-55 recite additional features of the present invention disclosed in paragraphs [0016, 0045-0054] and throughout the specification. Additionally, Applicants amended dependent claims 15-18, 23-26, 28, 29, 31, and 36-39 to provide additional context and details of the present invention. Applicants also amended paragraphs [0008, 0017, 0045, 0047, 0052, 0053, 0063, 0066, and 0067] in the specification to correct minor typographical errors. Upon reviewing the drawings and specification, Applicants discovered that reference numeral 120 was inadvertently repeated. To correct for this error, Applicants amended the specification by assigning reference numeral 190 to the "consultant module" disclosed in paragraphs [0045 and 0066]. If this change meets with the Examiner's approval, Applicants will correct the drawings to reflect this change.

Applicants respectfully submit that no new matter was introduced by these amendments. As now recited, claims 14-18, 23-31, 36-39, and 49-55 are currently pending and are believed to be in condition for allowance. Applicants respectfully request reconsideration of this application in light of the above amendments and the following remarks.

A. Claim Rejections under 35 U.S.C. § 112, second paragraph

Claims 14-18, 23-31, and 36-39 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. In view of the amendments above and the comments below, Applicants respectfully request reconsideration and withdrawal of this rejection.

With regard to claims 14-18 and claims 23-26, amended independent claim 14 currently recites a pharmacy benefits management system comprising pharmacy benefits means for receiving claim information relating to pharmacy benefits claims processed by a claims processing facility, said claim information including identification of drugs dispensed to patients; management means for receiving pharmacy benefits formulary information and price information relating to drugs in various classes; and provider means for receiving pharmacy benefits plan structure information including deductible information and co-payment information stored in the provider means to determine a recipient's prescription benefit plan and identify the subscriber of the prescription benefit plan. Claim 14 further recites that the management means further calculates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information. Additionally, claim 14 recites that the management means further aggregates the out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon at least one of identity of drug dispensed, type of drug dispensed, formulary information, identity of pharmacy dispensing drug, and identity of doctor prescribing drug. Further, claim 14 recites that the management means causes the aggregated out-of-pocket costs and sponsor costs to be displayed to the recipient of prescription benefits.

In the above amendment, Applicants amended claim 14 and reworded the claim with additional detail and context. In view of the amendment to claim 14, Applicants respectfully submit that the rejection of claim 14 under 35 U.S.C. § 112, second paragraph, is moot and request reconsideration and withdrawal of this rejection. Since claims 15-18, 23, and 24 are dependent upon claim 14, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, of these dependent claims as well.

Additionally, with regard to the “wherein” clauses of claims 15-18, 23, and 24, Applicants respectfully submit that these clauses in the respective dependent claims add additional detail to the system recited in independent claim 14. Claim 15, for example, specifies that the identified drugs in accordance with the pharmacy benefits claim information are drugs previously dispensed to a patient. Therefore, the expenses associated with these selected drugs are of a historical nature. The structure of the pharmacy benefits means recited in independent claim 14 may be modified according to dependent claim 15 to include means for receiving the information regarding these drugs.

Likewise, the “alternative drugs” of claim 16 are therapeutic alternatives to the selected drugs, such as those alternatives disclosed in the specification in at least paragraphs [0055-0057, 0063, and 0068]. Similarly, the pharmacy benefits means of claim 16 may include means for receiving information regarding these alternatives as well.

Dependent claims 17, 18, 23, and 24 also include additional features to independent claim 14, and Applicants respectfully submit that these claims are in proper format to modify independent claim 14 as each of the recited dependent claims provides additional features related to the function that the means of the claim performs. As such, Applicants respectfully submit that the claims properly comply with 35 U.S.C. § 112, second paragraph, since the functional limitations recited in these dependent claims convey the scope of the respective limitation (e.g., selected drugs are the drugs previously dispensed to a patient) to a person of ordinary skill in the pertinent art. See also MPEP 2171. As such, the claims are definite in accordance with 35 U.S.C. § 112, second paragraph.

As well, Applicants respectfully submit that these means plus function claims properly comply with 35 U.S.C. § 112, sixth paragraph as well, since the written description links or associates particular structure, materials, or acts to the function recited in the means plus function claim limitation. See *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1381 (Fed. Cir. 1999); see also MPEP 2181 (II). Applicants respectfully request reconsideration and withdrawal of the indefiniteness rejection of claims 14-18 and claims 23-26 under 35 U.S.C. § 112, second paragraph.

Similarly, claims 36-39 depend from amended independent claim 27. Applicants amended claim 27 to recite a pharmacy benefits management method of the present using active steps. Applicants also amended claims 36-39 to add additional detail to the steps of independent claim 27. As such, Applicants respectfully submit that the previous rejection of

claims 36-39 under 35 U.S.C. § 112, second paragraph, is moot. As such, Applicants respectfully request the reconsideration and withdrawal of this rejection.

B. Claim Rejections under 35 U.S.C. § 103

Claims 14-18, 23-31, and 36-39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pack-Harris U.S. Patent No. 6,195,612 (the '612 patent) in view of Mayaud U.S. Patent No. 5,845,255 (the '255 patent). In view of the amendments above and the comments below, Applicants respectfully request reconsideration and withdrawal of this rejection.

As discussed in the recent personal interview, the present invention is generally directed to a pharmacy benefits management system and a method of managing pharmacy benefits by acquiring claim and benefit information and then processing and displaying aggregate out-of-pocket and sponsor costs to recipients of prescription benefits.

For example, amended independent claim 14 recites a pharmacy benefits management system comprising pharmacy benefits means for receiving claim information relating to pharmacy benefits claims processed by a claims processing facility, said claim information including identification of drugs dispensed to patients; management means for receiving pharmacy benefits formulary information and price information relating to drugs in various classes; and provider means for receiving pharmacy benefits plan structure information including deductible information and co-payment information stored in the provider means to determine a recipient's prescription benefit plan and identify the subscriber of the prescription benefit plan. Claim 14 further recites that the management means further calculates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information. Additionally, claim 14 recites that the management means further aggregates the out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon at least one of identity of drug dispensed, type of drug dispensed, formulary information, identity of pharmacy dispensing drug, and identity of doctor prescribing drug. Likewise, claim 14 recites that the management means causes the aggregated out-of-pocket costs and sponsor costs to be displayed to the recipient of prescription benefits.

In contrast, the '612 patent appears to discuss a conventional pharmacy benefit management system to provide a medical group with costs and utilization rates by individual physicians and the group relative to pharmacy benefit capitation (see the '612 patent, col. 2, lines 26-32). The system of the '612 patent provides a medical group with information regarding the drugs obtained, and their actual costs, based on the prescription activity of the medical group physicians (see col. 2, lines 33-38). This is quite different from the present invention, which is directed to providing pharmacy management information to the actual recipient consumer of the health care benefits to examine what is being charged with complete market transparency rather than to the person making the prescribing decision in a usage and activity environment as in the '612 patent.

The Examiner refers to column 5, lines 35-59 and to Figure 3 in asserting that the '612 patent discloses the correlating means. However, amended independent claim 14 now recites management means that calculates, aggregates, and causes out-of-pocket costs and sponsor costs to be displayed. The focus is on providing both out-of-pocket costs that a prescription recipient may receive as well as the sponsor costs borne by an employer or other third party payer. With this information, the recipient may evaluate total costs of the particular drug benefit. Similarly, the recipient and sponsor may collaborate to determine the efficacy of the offered prescription drug benefit. The cited portion of the '612 patent fails to disclose these features recited in amended independent claim 14. Instead, the '612 patent discloses only the prescription cost of a particular drug. Nowhere does the '612 patent evaluate and disclose the out-of-pocket costs and sponsor costs of a particular drug benefit.

Likewise, the '255 patent fails to cure the deficiencies of the '612 patent. The Examiner cited the '255 patent to allegedly disclose pharmacy benefits formulary information, but the '255 patent is an electronic prescribing tool used to improve the quality of prescriptions written (see the '255 patent, col. 4, lines 21-26). While the '255 patent discloses that the data may be aggregated for multiple users, an individual user's prescribing pattern may be reviewed by the user or by others for formulary compliance (col. 13, lines 49-56). Ensuring formulary compliance is not the same as structuring information related to a formulary multi-tier benefits program as recited in the present claims. Further, the environment in which the '255 patent may be practiced is not that of a drug benefit recipient or an employer seeking market transparency to control prescription drugs costs, but rather the

“user” of the ‘255 patent is a physician or physician group seeking to provide additional details when they prescribe medication.

There is no disclosure in the ‘255 patent of management server means that calculates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information as recited in amended independent claim 14 of the present application. The present invention brings the consumer of pharmacy benefits into the drug selection process by providing decision support as to the prescribed and available drugs. The pharmacy benefit recipient is at the center of the present invention, while in the ‘255 patent, there is no recipient listed as a “user.” Instead, physicians and physician groups are the system users.

Accordingly, Applicants respectfully submit that the cited references, either alone or in combination, fail to disclose each and every feature of amended independent claim 14. As such, Applicants respectfully assert that amended independent claim 14 is allowable over the cited references and request reconsideration and withdrawal of the rejection of claim 14 under 35 U.S.C. § 103.

Dependent claims 15-18, and 23-26 are dependent upon claim 14 and thereby include all the limitations of amended independent claim 14, while reciting additional features of the present invention. Applicants respectfully traverse the rejection of claims 15-18, and 23-26 for similar reasons as outlined above with regard to the rejection of claim 14 under 35 U.S.C. § 103. As discussed above, Applicants respectfully submit that the cited references, either alone or in combination, fail to disclose all the elements and limitations recited in amended independent claim 14 of the present application. Therefore, the applied reference fails to disclose all the features and limitations of amended dependent claims 15-18, and 23-26 as well.

Accordingly, Applicants respectfully submit that claims 15-18, and 23-26 are allowable by virtue of their dependency upon claim 14 as outlined above. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 15-18, and 23-26 under 35 U.S.C. § 103.

Amended independent claim 27 recites a pharmacy benefits management method performed by the system of claim 14. Applicants amended claim 27 to include the limitations

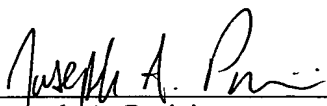
discussed above with regard to recipients receiving the benefits information as well as the out-of-pocket costs and sponsor costs. Applicants further amended independent claim 27 to recite the active steps performed in a method of the present invention. As above, by virtue of these amendments, Applicants respectfully assert that the cited references, either alone or in combination, fail to disclose each and every feature of amended independent claim 27. As such, Applicants submit that amended independent claim 27 is allowable over the cited references and request reconsideration and withdrawal of the rejection of claim 27 under 35 U.S.C. § 103.

Amended dependent claims 28-31 and 36-39 are dependent upon claim 27 and thereby include all the limitations of amended independent claim 27, while reciting additional features of the present invention. Applicants respectfully traverse the rejection of claims 28-31 and 36-39 for similar reasons as outlined above with regard to the rejection of claim 27 under 35 U.S.C. § 103. As discussed above, Applicants respectfully submit that the cited references, either alone or in combination, fail to disclose all the elements and limitations recited in amended independent claim 27 of the present application. Therefore, the applied reference fails to disclose all the features and limitations of amended dependent claims 28-31 and 36-39 as well.

C. Conclusion

In view of the above amendments and remarks, Applicants respectfully request the Examiner's reconsideration of this application and the timely allowance of the pending claims.

Respectfully submitted,
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